

REMARKS

Claims 1 – 23 are currently pending in the present application. In a Response to Election Requirement filed July 7, 2003, Applicants provisionally elected a species as represented by Fig. 9 and including claims 1 – 5, 8 – 21, and 23. As such, claims 6, 7, and 22 are withdrawn and, by this Response and Amendment, claims 1 – 5, 8 – 21, and 23 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, claims 1 – 5, 8 – 13, 17 – 21 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP 08-090893 (hereinafter referred to as “the JP ‘893 reference”) in view of U.S. Patent No. 5,320,042 to Schwöpfinger (hereinafter referred to as “the Schwöpfinger ‘042 reference”); and claims 14 – 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP 08-090893 in view of the Schwöpfinger ‘042 reference in further view of U.S. patent no. 5,509,353 to Aoki (hereinafter referred to as “the Aoki ‘353 reference”).

By this Response and Amendment,
the rejections to the claims have been traversed;
proposed replacement drawings of Figs. 1 and 2 are submitted showing that prior art is being depicted; and
the specification has been amended to eliminate references to specific claims.

The amendments do not introduce new matter within the meaning of 35 U.S.C. § 132.
Accordingly, entry of the amendments is respectfully requested.

Drawings

The Examiner objected to the drawings as not properly designating Figs. 1 and 2 as “Prior Art.”

Response

Applicants note with appreciation the Examiner’s suggestions for correction. By this

Response and Amendment, Applicants have submitted replacement drawings. As such, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the drawings.

Objections to Specification

The Examiner objected to the specification as having improper references to specific claims.

Response

By this Response and Amendment, Applicants have amended the specification to eliminate references to specific claims. As such, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the specification.

Claim Rejections Under 35 U.S.C. §103(a) In View Of The '042 Patent

The Examiner rejected claims 1 – 5, 8 – 13, 17 – 21 and 23 under 35 U.S.C. §103(a) as being unpatentable over JP 08-090893 in view of the Schwöpfinger '042 reference.

Response

Applicants respectfully traverse this rejection because there is no motivation to combine the JP '893 reference with the Schwöpfinger '042 reference.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it

would be obvious to modify the references to produce the present invention. *See Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 974.

Independent claims 1 and 17 of the present patent application contain limitations that are not taught by the prior art. Claims 1 and 17 recite a stencil printing machine having a printing section composed of a rotary printing drum with an outer circumferential periphery to which a stencil sheet is mounted and also recite first and second rotary press members. The second rotary press member is recited as including an outer circumferential periphery formed with micro-convexities and micro-concavities.

The Examiner asserts that the JP '893 reference teaches the detailed structure of a screen printing apparatus including a first printing section having a printing drum and a press drum and a downstream printing section having a screen printing drum and a press drum. However, as the Examiner notes, the JP '893 reference does not show a pressure drum having micro-convexities and micro-concavities. The Examiner relies on the '042 patent as a secondary reference to meet the micro-convexity and micro-concavity limitations. The JP '893 reference also teaches the application of a cleaning means 64 by an application roller 65 to the surface of pressure drum 63. After the cleaning means is applied, excess cleaning means is cleaned from the surface of pressure drum 63 using a first scraper blade 67.

"In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 13 USPQ2d 11301 (Fed. Cir. 1989). Contrary to the Examiner's assertion, Applicants submit that it would not have been obvious to provide the second press drum surface of the JP '893 reference with micro-convexities and micro-concavities in order to

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keep the press-drum surface from being smeared by freshly printed ink. Making such a modification would render the Japanese reference inoperative and, therefore, not enabling. The JP '893 reference includes a first scraper blade 67, which serves to remove cleaner from the outer surface of the pressure drum 63. Applying micro-concavities and micro-convexities to the surface of the pressure drum 63 would render the scraper blade 67 ineffective because it would not be able to properly remove all of the cleaner from the outside surface of pressure drum 67. *See In re Gordan*, 733 F.2d 900 (fed. Cir. 1984) (If modifying the prior art renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification); *see also In re Ratti*, 270 F.2d 810, (CCPA 1959) (If the proposed modification or combination changes the principle of operation of the prior art, then the references do not support a *prima facie* showing of obviousness). Accordingly, Applicants submit that the micro-concavities and micro-convexities of the Schwöpfinger '042 reference would render scraper blade 67 of the JP '893 reference inoperative and, therefore, negate any motivation to combine the JP '893 reference with the Schwöpfinger '042 reference.

As such, Applicants submit that independent claims 1 and 17 are not rendered obvious by the JP '893 reference in combination with the Schwöpfinger '042 reference since the cited combination would be inoperative for its intended purpose. Therefore, claims 1 and 17 are patentable over the cited references.

Also, because dependent claims contain all of the limitations of the independent claims from which they depend, dependent claims 2 – 5, 8 – 13, and 18 – 21, and 23 are patentable over the cited references for at least the same reasons as original independent claim 1 and previously presented claim 17.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections.

Claim Rejections Under 35 U.S.C. §103(a) In Further View Of The '353 Patent

The Examiner rejected claims 14 – 16 under 35 U.S.C. §103(a) as being unpatentable over the JP '893 reference in view of the Schwöpfinger '042 reference in further view of the Aoki '353 reference.

Response

For the same reasons set forth above with respect to the Examiner's rejection of amended independent claim 1, Applicants respectfully traverse the Examiner's rejection.


Claims 14 – 16 contain all of the limitations of independent claim 1; therefore, said claims are patentable over the cited references for at least the same reasons as independent claims 1 and 17. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections.

CONCLUSION

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejection and allow all pending claims herein. Applicants respectfully request the Examiner to contact the undersigned attorney, if the Examiner thinks it necessary to expedite examination of the present application.

Respectfully submitted,
NATH & ASSOCIATES PLLC

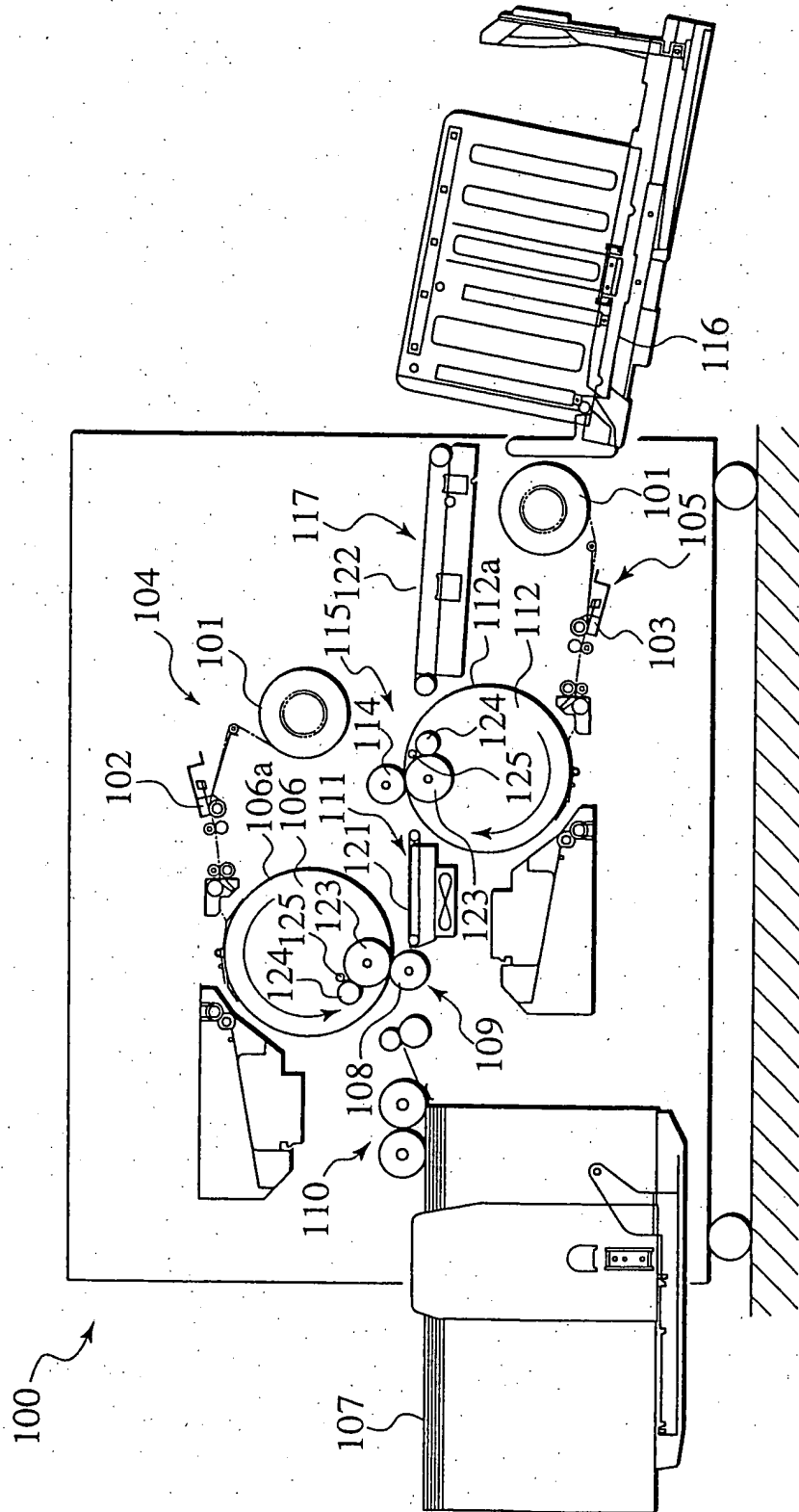
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Replacement Sheet

FIG. 1



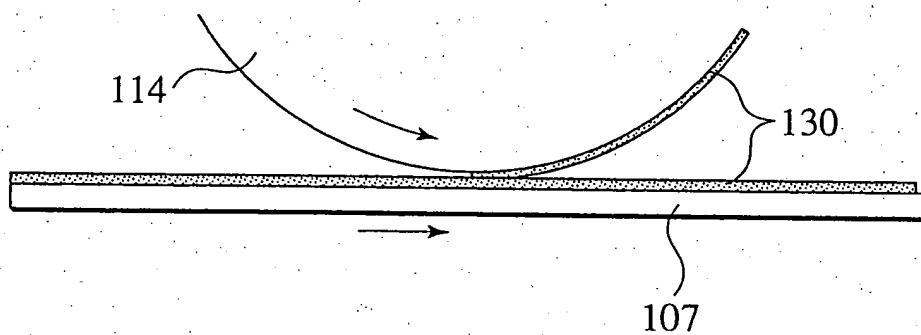
Prior Art



Replacement Sheet

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FIG.2



Prior Art